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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,955	01/26/2006	Lutz Wolfgang Gruneberg	051082	8456
20306 7590 05/13/2009 MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
KARIKARI, KWASI				
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2617				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/565,955

**Applicant(s)**

GRUNEBERG ET AL.

**Examiner**

KWASI KARIKARI

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/04/2009 has been entered.

**Response to Arguments**

2. Applicant's arguments, filed on 03/04/2009 with respect to claims 1-15 in the remarks, have been considered but are moot in view of the new ground(s) of rejection.

**Claim Objections**

3. Claims 7-9 are neither open-ended nor closed-ended because they are missing transitional phrases such as "consisting" or "comprising". Appropriate corrections are required to address any ambiguities in the claims.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 4-10 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoifo et al., (US 20010034709 A1), (hereinafter, Stoifo).**

**Regarding claims 1 and 10**, Stoifo teaches a system/method for handling email requests for sending and receiving email from a terminal, the system (= user computer 101; user email address; and contact of user via proxy email address, see [0005, 0011 and 0024]; whereby having an email address is an inherent feature for sending and receiving email) comprising:

at least one email proxy and a database, the email proxy being configured to communicate with the database (= portal server 107 uses an identity bank, see [0012, 0021 and Fig. 2], whereby the "email proxy" is being associated with portal server 107),

wherein the email proxy is configured to detect a unique network address of the terminal (= user sends true identification such IP address to the portal server 107, see [0011]) and retrieve email configuration settings from the database using the unique network address of the terminal (= portal server 107 assigns proxy identification that matches user's identification, see [0004, 0012, 0021 and 0025]; whereby the proxy identification is being associated with the "email configuration settings") and, without sending the retrieved email configuration settings back to the terminal, to communicate with an email server using the retrieved email configuration settings (= portal server 107 uses the proxy identification to forward the request message to Web server 103; and the Web server computer can be browsed once links between computer 101, portal server and Web server 103 have been established, see [0012, 0019 and 0030]).

**Regarding claims 4 and 13**, as recited in claims 1 and 10, Stoifo discloses the system wherein the database comprises a mapping of the unique network address of the terminal to an identity of a user (= portal server 107 assigns proxy identification that matches user's identification, see [0004, 0012 and 0021]).

**Regarding claims 5 and 14**, as recited in claims 4 and 13, Stoifo discloses the wherein a first database comprises the mapping of the unique network address of the terminal to the identity of the user, and second database comprises the retrieved email configuration settings (see [0021]).

**Regarding claims 6 and 15**, as recited in claims 1 and 10, Stoifo disclose that a first email proxy is used to handle email requests for retrieving email messages, and a second email proxy is used to handle email requests for sending email messages (= portal server 107, Web server computer 103; and user email address, see [0004, 0011-12 and 0024])

**Regarding claim 7**, Stoifo discloses an email retrieval proxy for handling email retrieval requests from a terminal (= user computer 101; user email address; and contact of user via proxy email address, see [0005, 0011 and 0024]; whereby having an email address is an inherent feature for sending and receiving email),

the email retrieval proxy being configured to detect a unique network address of the terminal (= user sends true identification such IP address to the portal server 107,

see [0011]) and retrieve email configuration settings from a database using the unique network address of the terminal without sending the retrieved email configuration settings back to the terminal, (= portal server 107 assigns proxy identification that matches user's identification, see [0004, 0012, 0021 and 0025]; whereby the proxy identification is being associated with the "email configuration settings")

the email retrieval proxy further being configured to forward the email retrieval request to an email server using the retrieved email configuration settings and to retrieve a requested email message from the email server and forward the requested email message to the terminal (= portal server 107 uses the proxy identification to forward the request message to Web server 103; and the Web server computer can be browsed once links between computer 101, portal server and Web server 103 have been established, see [0012, 0019 and 0030]).

**Regarding claim 8**, Stoifo discloses an email sending proxy for handling email sending requests from a terminal (= user computer 101; user email address; and contact of user via proxy email address, see [0005, 0011 and 0024]; whereby having an email address is an inherent feature for sending and receiving email),

the email sending proxy being configured to detect a unique network address of the terminal (= user sends true identification such IP address to the portal server 107, see [0011]) and retrieve email configuration settings from a database using the unique network address of the terminal without sending the retrieved email configuration settings back to the terminal, (= portal server 107 assigns proxy identification that

matches user's identification, see [0004, 0012, 0021 and 0025]; whereby the proxy identification is being associated with the "email configuration settings")

the email sending proxy further being configured to modify the email sending request using the retrieved email configuration settings and to forward the modified email sending request to an email server using the retrieved email configuration settings (= portal server 107 uses the proxy identification to forward the request message to Web server 103; and the Web server computer can be browsed once links between computer 101, portal server and Web server 103 have been established, see [0012, 0019 and 0030]).

**Regarding claim 9,** Stoifo discloses a terminal for use with a system of claim 1

(= user computer 101; user email address; and contact of user via proxy email address, see [0005, 0011 and 0024]; whereby having an email address is an inherent feature for sending and receiving email), the terminal being provisioned with default configuration settings for sending or retrieving email messages (= portal server 107 assigns proxy identification that matches user's identification, see [0004, 0012, 0021 and 0025]; whereby the proxy identification is being associated with the "default configuration setting"), the default configuration settings being the same for each mobile terminal operating within a network, wherein the mobile terminal is configured to send email messages to or retrieve email messages from an email server, via an email proxy, using the default configuration settings (= proxy identities are reuse by different user, portal server 107 uses the proxy identification to forward the request message to Web

server 103; and the Web server computer can be browsed once links between computer 101, portal server and Web server 103 have been established, see [0012, 0019, 0022 and 0030]).

**5. Claims 2-3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoifo in view of Applicant's admitted prior art (hereinafter, APA).**

**Regarding claim 2**, as recited in claim 1, **Stoifo** does not explicitly teach about email configuration settings including -- a name of an email server, and a username and a password for accessing the email server, as claimed by applicant.

However, **APA**, teaches that -- a name of an email server, a user name and a password are known to be used for email retrieval (see page 2, lines 1-4. (7)).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of APA with Stoifo to achieve a system that uses a name of an email server, a user name and a password for email retrieval.

**Regarding claim 3**, as recited in claim 2, **Stoifo** does not explicitly teach the system, wherein the email configuration settings further include: a full name of a user and an email address of the user.



However, **APA**, teaches the system, wherein the email configuration settings further include: a full name of a user (see page 2, lines 16-20), and an email address of the user (see page 2, lines 16-20).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of APA with Stoifo to achieve a system that uses a name of an email server, a user name and a password for email retrieval.

**Regarding claim 11**, as recited in claim 10, the features of claim 11 are similar to the features of claim 2. Hence, claim 11 is rejected on the same ground and motivation as claim 2.

**Regarding claim 12**, as recited in claim 11, the features of claim 12 are similar to the features of claim 3. Hence, claim 12 is rejected on the same ground and motivation as claim 3.

### **CONCLUSION**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached form PTO-892 for cited references and the prior art made of record.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to

specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. **SEE MPEP 2141.02 [R-5] VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS: A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.** W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). >See also MPEP §2123.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (9am - 7pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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